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REMARKS/ARGUMENTS

Claims 1-9 have been cancelled and Claim 10 has been added. Claim 10 defines the structures disclosed in more definite terms than previous Claims 1-9. The Claims 1-9 were rejected under 35 U.S.C. § 112 and § 103. These rejections are believed to be moot in view of the above amendment. It should be remembered that a rejection under 35 U.S.C. § 103 must comply with the directives of the courts as set forth in the following discussion.

A holding that combination claims are invalid based merely upon finding similar elements in separate prior art patents would be "contrary to statute and would defeat the congressional purpose in enacting Title 35.

For example, see *In re Geiger* Unpublished decision (12/11/86)

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." Judge Archer.....Judge Newman found that the applicant had shown, by evidence, that his system had superior properties not rendered obvious by the cited references.

The requirements necessary to support a conclusion that a claim is directed to "obvious" subject matter is found in *Ex parte Clapp*, 227 USPQ 972 (TTAB 1985).

[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Laskowski, 10 USPQ2d 1397, 1398 (Fed Cir. 1989), citing In re Gordon, 221 USPQ 1125, 1127 (Fed Cir. 1984).

With further reference to *Ex parte Clapp*, *Supra*, at 973:

To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. ...It is to be noted that simplicity and hindsight are not proper criteria for resolving the issue of obviousness.

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And, as stated in *Connell v. Sears, Roebuck and Co.*, 722 F.2d 1542, 1549, 220 USPQ 193, 199 (Fed. Cir. 1983):

The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made.

A precise statement as to the impropriety of a rejection, under 35 U.S.C. § 103 is found in the opinion of the CCPA rendered in the decision of *In re Linnert*, 309 F.2d 498, 503; 135 USPQ 307, 311 (1962):

Viewed in the light of the appellants' specification, the solution to the problem ... may seem obvious over the combined teachings of the references. Such a hindsight analysis, however, is not allowed by 35 U.S.C. § 103 which requires a comparison of the prior art and the invention as a whole at the time the invention was made.

The CCPA went on to state:

It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill of the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of claims, it is not the type of rejection which the statute authorizes. 35 U.S.C § 103 is very specific in requiring that a rejection on the grounds the invention "would have been obvious" must be based on a comparison between the prior art and the subject matter as a whole at the time the invention was made.

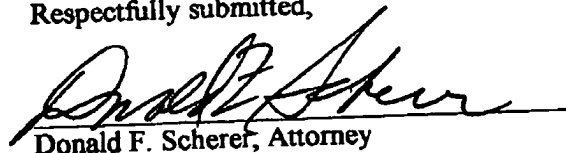
The Examiner has questioned the use of a stationary or non-rotating piston with a rotating torque-transmitting mechanism commonly termed a "clutch". As is well known rotating torque transmitting mechanisms have an apply piston, an apply plate, a plurality of friction plates, and a back-up or reaction plate. The apply piston and the apply plate are axially adjacent and generally rotate in unison with a first of the friction plates. However, it is known to have the apply piston slidably disposed in a non-rotating housing. In these devices, the apply piston and the apply plate are separated by an anti-friction mechanism such as a needle bearing or a roller bearing. The anti-friction device accommodates the

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relative rotation that occurs between the apply piston and the apply plate. Such devices are not new and have been proposed in the past to accommodate the transmission designer.

In view of the above amendments and remarks, this application is believed to be in condition for allowance, which is herewith respectfully requested.

Respectfully submitted,



Donald F. Scherer, Attorney
Reg. No. 24,539
810-953-9268